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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,258	10/21/2003	Oscar A. Chappel	27117-P022P1	3419
61060	7590	11/27/2009		
WINSTEAD PC P.O. BOX 50784 DALLAS, TX 75201			EXAMINER LE, LINH GIANG	
			ART UNIT 3686	PAPER NUMBER
			MAIL DATE 11/27/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/690,258	<b>Applicant(s)</b> CHAPPEL, OSCAR A.	
	<b>Examiner</b> MICHELLE LE	<b>Art Unit</b> 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 23-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>041309</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to Amendment and Remarks filed 20 July 2009. Claims 15-22 have been canceled. Claims 2—30 have been added. Claims 1, 3-4, 6, 9, and 11-12 have been amended. Claims 1-14 and 23-30 are pending for examination.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 13 April 2009 was filed after the mailing date of the Non-Final Office Action on 2/19/09. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-8, 23-25 and 29-30 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88

USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). Furthermore, a nominal recitation in the preamble of structure in an otherwise ineligible method fails to make the process statutory.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

Applicant has amended the claims to recite a hardware server in the "creating" step in independent claims 1 and 29. However, Examiner submits this recitation does not impose meaningful limits in the scope of the claims. The "creating" step merely gathers data from a claim forms on a server and is considered extra-solution activity. To impose meaningful limits, it is suggested Applicant clarify what particular machine, if any, is performing the "applying" and "populating" functions.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 9, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by McIntosh (2002/0128874).

7. As per claim 1, Jones teaches a method of populating a knowledge base, the method comprising:  
creating, on at least one hardware server in a computing system, at least one claim element based on information related to a field from a claim form (Jones; Col. 5, lines 12-16);  
applying at least one knowledge-base-population rule to said at least one claim element to form claim-processing knowledge for the at least one claim element (Jones; Col. 5, lines 18-27); and  
populating the knowledge base with said claim-processing knowledge acquired from

said applying step, the knowledge base being resident in a computer-readable storage medium in the computing system (Jones; Col. 7, lines 20-25).

8. As per claim 9, Jones teaches an article of manufacture for populating a knowledge base used in validating medical claims, the article of manufacture comprising:

at least one computer readable medium (Jones; Col. 3, lines 25-45);

processor instructions included on the at least one computer readable medium, the processor instructions configured to be readable from the at least one computer readable medium by at least one processor and thereby cause the at least one processor to operate as to (Jones; Col. 3, lines 15-45):

create at least one claim element based on information related to a field from a claim form (Jones; Col. 5, lines 12-16);

apply at least one knowledge-base-population rule to said at least one claim element to form claim-processing knowledge for the at least one claim element (Jones; Col. 5, lines 18-27);

and populate the knowledge base with claim-processing knowledge acquired from said applying step (Jones; Col. 7, lines 20-25).

9. Claim 29 repeats substantially the same limitations as claims 1 and 9 and the reasons for rejection are incorporated herein.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-8, 10-14, 23-28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (7,571,107) in view of McIntosh (2002/0128874).

11. As per claim 2, McIntosh teaches further comprising translating an edit to yield a translated edit, the translated edit being utilized in the step of creating the at least one claim element (McIntosh; para 33).

12. As per claim 3, McIntosh teaches further comprising binding at least one conclusion variable responsive to the applying step of the at least one knowledge-base-population-rule (McIntosh; para. 26). Examiner submits that the phrase “reject the claim” reads upon a “conclusion variable.”

13. As per claim 4, McIntosh teaches wherein the step of creating the at least one claim element comprises:

creating at least one attribute (McIntosh; paras. 31 and 32); and  
assigning at least one value to said at least one attribute (McIntosh; paras. 31 and 32).

14. As per claim 5, McIntosh teaches further comprising validating a claim using appropriate claim-element knowledge in the populated knowledge base (McIntosh; para. 24).

15. As per claim 6, McIntosh teaches wherein the step of creating the at least one claim element comprises the steps of:  
creating at least one reference claim element (McIntosh; paras. 20-24); and  
creating at least one reported claim element (McIntosh; paras. 20-24).

16. As per claim 7, McIntosh teaches further comprising the step of validating a claim by comparing said at least one reported claim element to said at least one reference claim element (McIntosh; para. 24).

17. As per claim 8, McIntosh teaches further comprising the step of verifying that the translated edit has been correctly translated (McIntosh; paras. 26-29).

18. As per claim 23, McIntosh teaches wherein the at least one claim element includes a plurality of edits, the plurality of edits representing situations that hinder claim payment by a payer (McIntosh; para. 33).

19. As per claim 24, McIntosh teaches where the applying step comprises applying the knowledge-base-population rule to at least one of the plurality of edits to acquire the claim-processing knowledge (McIntosh; paras. 33 and 34).

20. As per claim 25, McIntosh teaches wherein the plurality of edits comprises a plurality of translated edits, wherein at least one translated edit in the plurality of translated edits represents at least a portion of an edit in a syntactical form that facilitates application of a knowledge-base-population rule applied thereto (McIntosh; paras. 33 and 34).

21. It would have been obvious to add the features of McIntosh (as taught in claims 2-8, and 23-25) to the teachings of Jones to one of ordinary skill in the art. The McIntosh and Jones references show that the features were old and well known in the art. Since in the combination each element merely would have performed the same function as it did separately, one of ordinary skill in the art would have recognized the results of the combination were predictable.

22. Claims 10-14 repeat substantially similar limitations of claims 2-8 and thus the reasons for rejections are incorporated herein.

23. Claims 26-28 repeat substantially similar limitations of claims 23-25 and thus the reasons for rejections are incorporated herein.

24. Claims 30 repeat substantially similar limitations of claims 23-25 and thus the reasons for rejections are incorporated herein.

***Response to Arguments***

25. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELLE LE whose telephone number is (571) 272-8207. The examiner can normally be reached on 8 AM - 5PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gerald O'Connor can be reached on (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/M. L./  
Examiner, Art Unit 3686  
11/20/09

/Gerald J. O'Connor/  
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